REMARKS

CLAIM STATUS

Claims 1-27 are pending in this application. Claims 14 -23 have been withdrawn from consideration. It is again noted that claim 24 is an elected claim. Moreover, the outstanding improper "final" Action is incomplete as pending claim 24 has not been properly treated.

CLAIM AMENDMENTS

Claim 1 has been amended to make the meaning of the previous claim language as to the holding device having "a fixed orientation relative to the feed device and to the removal device" clearer without any change of claim scope. New claim 27 is added and further sets forth that the "holding device is non-pivoting." It is respectfully submitted that the language of this new claim does not introduce any new matter as it is fully supported in the specification, for example at page 3, line 3 of the present application.

AMENDMENT ENTRY

As the present outstanding Action has failed to treat claim 24 in terms of specifying the reasons for the rejection inadequately indicated in item 6) on the Office Action Summary (PTOL-326), the outstanding Action has been improperly made final, as discussed below, and entry of this Amendment is noted to be a matter of right and not discretion.

SUMMARY OF OFFICE ACTION

The outstanding Office Action is a second Office Action that has been improperly made final that presents a rejection of claims 1-3, 5, 6, 8-11, 13, 25 and 26 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,251,425 to Kern (hereinafter "Kern") and a rejection of claims 4, 7, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Kern.

IMPOPER ACTION FINALITY

As noted above, the present outstanding Action has failed to treat claim 24 in terms of specifying the reasons for the rejection indicated in item 6) on the Office Action Summary (PTOL-326). As noted in MPEP §707.07(d):

> Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection.

Not only does the outstanding Action violate MPEP §707.07(d), it violates Section 706.02(j) of the MPEP that notes that "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." This is more than mere guidance by the MPEP as 35 U.S.C. § 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly, setting forth all relied on rationales to support all rejections in an Office Action in a way that gives the applicant a fair opportunity to respond is mandated by the statute and not something that is left to the Examiner's discretion.

Accordingly as the mere mention that claim 24 is rejected in item 6) on the Office Action Summary (PTOL-326) violates 35 U.S.C. § 132, MPEP 706.02(j), and MPEP §707.07(d), the withdrawal of the finality of the outstanding Action and the provision of a proper Office Action that properly considers claim 24 is respectfully noted to be in order.

CLAIM REJECTION UNDER 35 U.S.C. § 102

Page 2 of the outstanding Action presents the above-noted rejection of claims 1-3, 5, 6, 8-11, 13 and 25 under 35 U.S.C. § 102(b) as being allegedly anticipated by Kern. This rejection is traversed.

As was noted in the last response:

> It is clear that the "packing trap 13" of Kern is improperly equated to the claim 1 recited "holding device" at page 3 of the outstanding Action. In this regard, the "packing trap 13" of Kern is not taught or suggested to have a fixed orientation relative to the feed device (read as being via 15, 16, 19, and 20 of

> Kern at page 3 of the outstanding Action) and the removal device (read as being via 20, 21, 43, and 44 of Kern at page 3 of the outstanding Action) or to be arranged relative to the feed device and the removal device with the claim 1 recited first angle and second angle.

The outstanding Action argues (at page 6 under the heading "Response to Arguments") that the Examiner's finding that the Kern "holding device (via 13) is fixed to specific point in respect to the feed and removal devices" because the pivot point is a point that is fixed and that this pivot point fixing meets the previous language of claim 1. However, the language of previously presented claim 1 cannot be reasonably interpreted to say the claim 1 holding device has one fixed point relative to the feed device and to the removal device. This is because previously presented claim 1 clearly recited that "**the holding device has a fixed orientation** [not just one point] relative to the feed device and to the removal device." This claim language cannot be reasonably equated to a teaching of just one point of the holding device having a fixed orientation. In this regard, it is well established that in giving any claim term its broadest reasonable interpretation the plain meaning (ordinary and customary meaning) must be used. See MPEP §2111.01III. The plain meaning of "the holding device" would be clearly understood by the worker of ordinary skill in the art and even a layperson to be different from the Examiner's attempted interpretation of this claim language being the same as a recitation that "one point of the holding device."

In any event, amended claim 1 now recites that "the **main surface** of the holding device has a fixed orientation relative to the feed device and to the removal device and maintains the same fixed orientation during feeding and removing of the envelope respectively in the feed and removal directions" (emphasis added). Clearly, "the **main surface** of the holding device" cannot be reduced to just a dimensionless pivot point and the language "and maintains the same fixed orientation during feeding and removing of the envelope respectively in the feed and removal directions" cannot be ignored. To make the unreasonable interpretation offered by the Examiner even clearer, new claim 27 requires that "the holding device is non-pivoting."

Accordingly, as Kern cannot be reasonably said to teach all the limitations of independent claim 1, the rejection of independent claim 1, and claims 2, 3, 5, 6, 8-11, 13 and 25, all of which

ultimately depend from claim 1, under 35 U.S.C. § 102(b) as being allegedly anticipated by Kern is clearly improper and should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 4, 7, and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kern. This rejection is respectfully traversed.

First, it is noted that claims 4, 7, and 12 all depend from amended independent base claim 1 and that the rationales offered to reject these claims do not cure the above-noted deficiencies of Kern as to not teaching or even suggesting all the subject matter recited by this amended independent base claim. Thus, the rejection of claims 4, 7, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Kern is improper for at least this reason.

In addition, the rationales offered to reject claims 4, 7, and 12 are also all in error for relying on improper substitutes for the showing of substantial evidence required under the Administrative Procedures Act. *See In re Lee*, 217 F.3d 1365, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present Application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By _____

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